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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,879	05/23/2001	Takaaki Amano	SCET 18.700	9468

7590 05/19/2006

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,879

Applicant(s)

AMANO ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Response To Applicant's Arguments

First, the objection to the abstract is being withdrawn, while the objection to the title is herein been maintained since the Examiner could not locate the amended title that the Applicant claimed that he had sent.

Second, Applicant argues that although the Examiner suggests that the motivation to combine Goldhaber with the "Official Notice" disclosure is to provide greater fault tolerance and to reduce downtime, however, the Applicant contends that this motivation appears to be **improper hindsight reasoning, as it does not arise from Goldhaber or the "Official Notice" and it is not specific to advertising.** The Examiner completely and respectfully disagrees with the Applicant's findings. Here, although the Applicant may disagree with the Examiner's reason or motivation to combine (i.e. to provide greater fault tolerance and to reduce downtime), however, this disagreement does not necessarily imply that the Examiner did not provide a reasonable motivational statement, as understood by those skilled in the art of computer technology. Further, the motivation to combine does not necessarily have to come or arise directly from the prior art for the general knowledge available to one of ordinary skills in the art at the time of the invention is also taken into account when a motivational statement is being formulated. Additionally, any system administrator or network technician would have easily understood the need to use a backup or mirror server together with a primary server serving the users, wherein the mirror server is a backup server specifically designed to provide a greater fault tolerance and to reduce downtime in case the primary server fails or crashes irrelevant of what type of data (advertising data and/or other type of data) is stored therein. The latter conclusion is well within the level of skills of an ordinary artisan. Moreover, the Examiner never read such

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motivational statement from the specification and did not need to since the materials disclosed in the "Official Notice" are well known to those skilled in the area of computer technology and the Examiner is very familiar with these materials for being an A+ Certified Computer Technician and a Novel Certified Engineer (CNE) with several years of field experience.

Finally, in response to the Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, **it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning**. However, so long as it takes into account only knowledge, which was within the level of an ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final**.

Detailed Action

Specification

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed. See 37 CFR 1.72.

Status of the claims

Claims 1-3 are now pending in the Instant Application.

General Comments

Regarding claim 2, in “a computer program product **capable of causing** an advertisement information supplying system to supply....”, the “computer program product”, which sounds like a software, is not capable by itself of causing or triggering any measurable action unless it is executed by a processor.

Furthermore, regarding claims 1-3, storing in a first storage apparatus or first Hard drive (first database) the advertisement information and points to be applied to the advertisement viewer for viewing the advertisement information and storing in a second storage apparatus or second Hard drive (second database) the advertisement information without the points do not add any patentable weight to the claimed invention. Indeed, storing the advertisement information and points in a first Hard drive (having a database) and storing only the advertisement in a second Hard disk (having a database) or using a Hard drive coupled to a server to store the advertisement information and points in a first database and the advertisement information without the points in a second database of the Hard drive, as recited in the claims, represents a design choice or design specification (matter of desires, matter of convenience), which does not directly impact the functionality of the system, which is configured to display advertising information to a viewer and to provide points to the viewer for reading the advertising

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information regardless of the location and the manner in which the advertisement information and the points are stored, as one skilled in the art of computer technology would have understood.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber, US Patent 5, 794, 210

As per claims 1-3, Goldhaber discloses a system wherein, in one embodiment, an advertiser 62 creates one or more ads 68 that appeal to certain consumers 64, not to others, in accordance with their interest profile 124 (targeted advertisements). The advertiser 62 provides or forwards the created and targeted ads 68 to the Attention brokerage server 106, for permanent storage and later retrieval (storage apparatus), acting as a broker or intermediary between the consumers or viewers 64 and advertisers 62, which transmits or routes the one or more created ads 68 to appropriate consumers 64, upon logging into the system or server 106, contingent upon their psychographic profile 124 (identification data), stored on the Attention brokerage server 106, matching the advertiser's 62 interest profile or criteria (displaying a targeted ad on the viewer's terminal 104 upon identifying the user or viewer when the viewer logs into the server or

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storage apparatus 106 over the network 102). In short, Attention brokerage servers 106 store information and disseminate it to consumers' computers 104 over a network 102 and the servers 106 provide the software agent 110 with targeted or tagged ads, directed to the consumers' or users' attention in accordance with their interest profile 124, to be viewed or reviewed by consumers 64. Moreover, in another embodiment, a software agent 110 related to a user's 64 device or computer 104, working on behalf of the user, screens and filters the incoming ads 68, provided to the Attention brokerage server 106 by advertiser or advertisement owner 62, transmitted by the Attention brokerage server 106 to be displayed to the user 64 based on the user's psychographic information 124 stored on the user's computer 104 local database 120. Subsequent to this screening or filtering process, matches achieving a certain threshold of interest (adjustable by the consumer who owns the profile) represented in the form of "agent reports" consisting of short summaries or thumbnails or pointers are displayed on the user's computer 104, wherein, upon activating a thumbnail view indicative of an ad matching, the user's computer 104 or the software agent 110 retrieves the full text and/or graphics corresponding to the matched advertisement 68. In other words, the software agent 110 maintains the user's psychographic or interest profile 124 confidential and performs the screening, filtering and matching itself based on a correlation between the ad criteria presented by the Attention brokerage server 106, on behalf of the advertiser 62, and the user's interest profile 124 stored on the user's computer 104. When matches are found, as indicated by the software agent 110, the Attention brokerage server 106, which stores in a database the advertiser's ads, delivers the matching ads to the user's computer 104 or the software agent 110

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may itself retrieve the matching ads from the Attention brokerage server 106 database to be displayed on the user's computer 104.

Alternatively, the software agent 110 may retrieve "thumbnail" brief summaries of the matching ads and display them along with associated Cybercoin icons on the user's computer 104, wherein upon activating a Cybercoin icon, using an input device, displayed next to a "thumbnail" brief summary representing a matching ad, the ad full text and/or graphics is retrieved and displayed to the user and the user is compensated in an amount equal to the value of the displayed Cybercoin.

Finally, it is further recognized upon accessing the network 102 (Internet) and inputting by the user or viewer the URL address of a web site related to the server 106, if the server 106 is down or otherwise inaccessible, then the network will return an error message and no ads are presented to the viewer or displayed on the viewer's computer 104.

(Col. 14: 17 to col. 15: 17; col. 15: 48 to col. 16: 5; col. 19: 26-31; col. 19: 36-61; col. 9: 53-61; col. 6: 24-31; col. 7: 8-19; col. 8: 41-48; col. 10: 9-38).

Goldhaber does not expressly disclose supplying the advertisement information related to the advertisement owner stored in an operative storage apparatus (backup device or backup computer system or mirror server) other than the selected storage apparatus in case that it is judged that the selected (primary) storage apparatus is not operative.

However, supplying or providing information to a customer or user from a backup system or mirror server when the primary server is down (not operational) is well established in the

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computer industry. In fact, it is common practice for system designers or administrators to create one more backup servers or mirror servers, storing a mirror image of the regular or primary servers content, to complement the regular servers and to even install these mirror or backup or redundant servers at different geographic locations to thereby provide great fault tolerance in case disasters, such as the World Trade Center Bombing in 1993, 9/11 event in 2001 or other natural occurrences, strike. With such a setup or design, the system can continue providing information or service to its users even when one or more regular servers are down.

Further, storing the advertisement information and points in a first Hard drive (having a database) and storing only the advertisement in a second Hard disk (having a database) or using a Hard drive coupled to a server to store the advertisement information and points in a first database and the advertisement information without the points in a second database of the Hard drive, as recited in the claims, represents a design choice or design specification (matter of desires, matter of convenience), which does not directly impact the functionality of the system, which is configured to display advertising information to a viewer and to provide points to the viewer for reading the advertising information regardless of the location and the manner in which the advertisement information and the points are stored, as one skilled in the art of computer technology would have understood.

“Official Notice”

Therefore, one skilled in the art would have been motivated at the time of the invention, without reading the present Application, to incorporate the above teachings (“Official notice”) into the Goldhaber’s system so as to establish one or more redundant or backup or mirror servers, storing a mirror image of the information contained in regular servers or Attention

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Brokerage servers 106, to complement or backup the regular servers 106(1)-106(n) and to install the mirror servers at different locations and to retrieve the advertisement information and other relevant data (such as points) from the closest mirror server upon determining that one or more servers 106 are down or off-line, thereby reducing down time or non-production time caused by the regular servers 106 malfunction or destruction while providing great fault tolerance in the system by installing the redundant or mirror servers at different geographic locations.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent %, 724, 521 to Dedrick discloses a system for storing a user's profile information, including user's interaction with displayed electronic content and/or advertisements, on the user's computer wherein no outside third party has access to the user's stored profile information.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719

05/13/06

JDJ

Jean D. Janvier

Patent Examiner

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JEAN D. JANVIER
PRIMARY EXAMINER
